

### **REMARKS/ARGUMENTS**

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-15 have been rejected in the Office Action. Claims 1, 2, 4-6, 8-13, and 15 have been amended. No new claims have been added and no claims have been canceled in this Amendment. Accordingly, claims 1-15 are pending herein. Claims 1-15 are believed to be in condition for allowance and such favorable action is respectfully requested.

Applicant's representative thanks Examiner Chow for granting a telephonic interview on December 21, 2006. During the interview, differences between the claimed invention and the applied art, namely U.S. Patent No. 6,311,327 to O'Brien et al. ("O'Brien"), were discussed. For instance, Applicant's representative argued that O'Brien fails to discuss: including unique tags at locations in a software program corresponding with text strings created by a software developer and descriptive of selected events in the software program (e.g., developer comments); removing the text strings from the software program; and creating an index mapping the unique tags in the software program with the text strings that have been removed from the software program. The Examiner disagreed with this position. Additionally, Applicant's representative noted that the claimed invention facilitates identifying events that have occurred when a software program is executed on a customer's computing device. In contrast, O'Brien is specifically directed to a software analysis system that includes probing hardware to analyze software as it is executed. The Examiner indicated that further amendments would be necessary to further set forth this distinction. Accordingly, Applicant has amended the independent claims to clarify distinctions between the claimed invention and the applied art as

described in further detail below. As such, it is respectfully submitted that the claims are in condition for allowance.

### **Amendments to the Claims**

Independent claims 1 and 9-11 are have been amended herein to further set forth the invention. Care has been exercised to avoid the introduction of new matter. Support for the amendments to claims 1 and 9-11 may be found in the Specification, for example, at p. 4, lines 7-22; and p. 6, lines 2-14.

Claims 2, 4-6, 8, 12, 13, and 15 haven been amended herein to correct minor errors and to correspond with the amendments made to independent claims 1 and 9-11. Cares has been exercised to avoid the introduction of new matter.

### **Rejections based on 35 U.S.C. § 103**

#### **A. Applicable Authority**

The requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)”. See MPEP § 2143. Further, in establishing a *prima facie* case of obviousness,

the initial burden is placed on the Examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985).” *Id.* See also MPEP § 706.02(j) and § 2142.

B. Rejections Based on O’Brien in view of the Current Application

Claims 1, 3, 7-10, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O’Brien in view of the current application. Applicant respectfully traverses this rejection, as hereinafter set forth.

Referring initially to independent claim 1, a method is recited for obtaining information regarding events to be taking place within a software program to be used by a customer on a computing device. The method includes a number of elements directed to creating an index mapping unique tags inserted into a software program to text strings that have been removed from the software program. In particular, the method recites: “including, for each of a number of selected events, an indicator within the software program that records the selected event, the indicator including a text string created by a software developer and descriptive of the selected event; assigning and including a unique tag corresponding to each text string; creating an index mapping each tag to the corresponding text string; prior to retail sale, removing each text string from the software program.” Accordingly, when the software program is released for retail sale, it includes unique tags corresponding with text strings that were previously included in the software program but were removed prior to retail sale. Additionally, an index is created that maps each unique tag to its corresponding text string.

In contrast, O'Brien fails to teach or suggest mapping a unique tag inserted into a software program with any text string that was previously included in the software program but removed from the software program prior to retail sale. Instead, O'Brien discusses creating a table that includes information for each tag, such as a location of the tag within the source code and/or information defining the type or category of the tag. *See, e.g., O'Brien*, col. 6, lines 55-65; col. 7, lines 37-42; col. 7, line 48 through col. 8, line 17; and col. 10, lines 18-21. None of the information included in the table comprises text strings that were previously included within the software program and removed from the software program.

The Office Action notes that O'Brien discusses removing comments from the source code. However, the comments removed from the source code in O'Brien are unrelated to the tags subsequently inserted into the code. In several locations, O'Brien discusses removing comments from the source code to form an intermediate form of the source code. The intermediate form is then analyzed to determine points of interest to instrument by inserting tag statements. *See e.g., id.*, col. 9, lines 41-56; col. 12, lines 3-41. There is no indication in O'Brien that the tags have any correlation to the removed comments or that any index is created mapping tags to removed comments. Instead, the tags inserted into the code appear to be completely unrelated to the comments that were previously removed.

Additionally, Applicant has amended independent claim 1 to further set forth the invention. In particular, the invention of claim 1, as amended, is directed to a method for obtaining information regarding events taking place within a software program when the software program is run on a customer's computer. In other words, the invention of claim 1 is concerned with obtaining information regarding the execution of the software program on a customer's computer. The amendments to independent claim 1 include the elements: "after

releasing the software program for retail sale, receiving a file of events as indicated by at least a portion of the unique tags included in the software program, the file being created when the software program is run on the computing device used by the customer; processing the file by using the index to map each unique tag in the file with its corresponding text string; and outputting a text string record of the events which took place within the software program.” Accordingly, after the software program has been released to retail sale, it may be run on a customer’s computer causing the creation of a file that includes unique tags from the software program indicating what events have taken place. The file created when the program is run on the customer’s computer is received and analyzed by using the previously created index to map unique tags in the file to corresponding text strings. A text string record is then output.

In contrast to the invention of claim 1, O’Brien is limited to implementations “in an embedded system without the requirement that the embedded system have on-board data storage and/or output port capabilities in a manner that does not consume system memory resources, including memory, processor time and I/O resources, of the target system.” *Id.*, col. 3, lines 20-25. O’Brien repeatedly refers to the use of a probe chassis 20, a ribbon cable 18, and a probe tip 12 to read the tags. *See, e.g., id.*, Figs. 1 and 2; col. 7, lines 21-30. Clearly, the technique discussed in O’Brien is not concerned with collecting information regarding events that occur within a software program when the program is run on a customer’s computer. Specifically, consumers generally do not own sophisticated probing hardware and certainly would not want to connect a probe when an application crashes.

Accordingly, O’Brien fails to teach or suggest multiple limitations of independent claim 1, as amended herein. O’Brien simply fails to teach or suggest a method in which prior to retail sale, an index is created mapping unique tags inserted into a software program to text

strings removed from the software program; and after retail sale, a file is created when the software program is run on a customer's computer and the file is processed to create a text string record by using the index to map unique tags in the file to corresponding text strings. Instead, O'Brien discusses only the use of probe hardware to read instrumented tags.

Applicant further respectfully submits that the background of the current application fails to cure the deficiencies of O'Brien. Moreover, there is simply no motivation to modify nor is O'Brien modifiable to achieve the invention of claim 1.

For at least the above-cited reasons, Applicant submits that independent claim 1 is non-obvious over O'Brien and the current application. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103(a). Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

Independent claims 9 and 10, as amended herein, contain limitations similar to those recited by independent claim 1, as amended herein. Accordingly, independent claims 9 and 10 are patentable over the combination of O'Brien and the current application for at least the reasons cited above with respect to independent claim 1, and Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 9-11.

Dependent claims 3, 7, 8, and 14 depend from independent claim 1. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 3, 7, 8, and 14 as well. Dependent claims 3, 7, 8, and 14 are believed to be in condition for allowance and such favorable action is respectfully requested.

C. Rejections Based on O'Brien, Current Application, and Biegel

Claims 2, 11, 12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brien in view of the current application and further in view of U.S. Patent No. 5,608,720 to Biegel et al. ("Biegel"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 2 depends from claim 1 and is patentable over O'Brien and the background of the current application for at least the reasons cited above with respect to independent claim 1. Additionally, the addition of Biegel fails to cure the above-cited deficiencies. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 2.

Independent claim 11, as amended herein, contain limitations similar to those recited by independent claim 1, as amended herein. Accordingly, independent claim 11 are patentable over the combination of O'Brien and the background of the current application for at least the reasons cited above with respect to independent claim 1. Moreover, the addition of Biegel fails to cure these deficiencies. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 11.

Dependent claims 12 and 15 depend from independent claim 1. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 12 and 15 as well. Dependent claims 12 and 15 are believed to be in condition for allowance and such favorable action is respectfully requested.

C. Rejections Based on O'Brien, Current Application, Biegel, and Treu

Claims 4-6 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brien in view of the current application further in view of Biegel and further in view of

U.S. Patent No. 5,245,615 to Treu ("Treu"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claims 4-6 and 13 depend from claim 1 and are patentable over O'Brien and the background of the current application for at least the reasons cited above with respect to independent claim 1. Additionally, the addition of Biegel and Treu fails to cure the above-cited deficiencies. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 4-6 and 13.

### **CONCLUSION**

For at least the reasons stated above, claims 1-15 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 1-15. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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